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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,381	08/22/2005	Nobuya Kaneko	04208.0210	3951

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EXAMINER	
GAMI, TEJAL	
ART UNIT	**PAPER NUMBER**
2121	

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12/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/517,381	KANEKO ET AL.	
	Examiner	Art Unit	
	Tejal J. Gami	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6 and 9-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6 and 9-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/03/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to a REQUEST FOR CONTINUED EXAMINATION entered November 19, 2007 for the patent application 10/517381.

Status of Claims

2. Claims 6 and 9-12 were rejected in the last Office Action dated May 17, 2007.

As a response to the May 17, 2007 office action, Applicant has Amended claims 6, 9, and 10; and Added claim 13.

Claims 6 and 9-13 are now pending in this office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, never specifically disclosed any mention of "properties sufficiently similar to the confidential main ingredient to permit substitution thereof when making a prototype similar to a prototype using the first main ingredient." Applicant's specification does not appear to provide support for what is claimed. There is simply no disclosure of any "substitution" within the specification as originally filed, and it is for this reason that the examiner contends this represents new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Norris et al. (WO 01/65441).

As to independent claim 13, Norris discloses a medicine prototype support system for an ingredient manufacturer developing medical product (e.g., pharmaceutical) at a request of a product manufacturer (see Page 5, First Paragraph) comprising:

a database comprising confidential (e.g., authorization; granted access) first main ingredient information and corresponding second main ingredient information (e.g., direct fit) (see Page 5, Last two Paragraphs), the first confidential (e.g., authorization; granted access) main ingredient information being confidential information of the product manufacturer (see Page 5, Second Paragraph);

information conversion means for selecting a second main ingredient by comparing (e.g., comparison 809) properties of the confidential main ingredient stored in the database with properties of a plurality of potential second main ingredients stored in the database (see Figure 8 for "a flow diagram of a general process for a user to sort through a formulation database to select a set of matching formulations);

composition ingredient determination means for selecting a composition ingredient based on the properties of the first and second main ingredients (see Page 8, Section 1. Formulation Know-How); and

communication means (e.g., server) for receiving confidential first main ingredient information from a product manufacturer (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph) and for transmitting selected second main ingredient information (e.g., formulation) and composition (e.g., components) ingredient information to a composition manufacturer system (e.g., customer for assembly) (see Page 13, Third Paragraph of Section 6. Formulation System), wherein the medicine prototype support system does not reveal the identity of the confidential first main

ingredient to the composition manufacturer system (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph) and the information conversion means (e.g., server) selects the second main ingredient such that it is impossible to estimate the development of the confidential first main ingredient from the second main ingredient (e.g., privately maintained formulation data) (see Page 11, Second Paragraph).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris et al. (WO 01/65441) and further in view of Iyer et al. (WO 00/79453).

As to independent claim 6, Norris discloses a medicine prototype support system for an ingredient manufacturer developing medical product (e.g., pharmaceutical) at a request of a product manufacturer (see Page 5, First Paragraph) comprising:

a database comprising confidential (e.g., authorization; granted access) first main ingredient information and corresponding second main ingredient information (e.g., direct fit) (see Page 5, Last two Paragraphs), the first

confidential (e.g., authorization; granted access) main ingredient information being confidential information of the product manufacturer (see Page 5, Second Paragraph);

composition ingredient determination means for selecting a composition ingredient based on the properties of the first and second main ingredients (see Page 8, Section 1. Formulation Know-How); and

communication means (e.g., server) for receiving confidential-first main ingredient information from a product manufacturer (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph) and for transmitting selected second main ingredient information (e.g., formulation) and composition (e.g., components) ingredient information to a composition manufacturer system (e.g., customer for assembly) (see Page 13, Third Paragraph of Section 6. Formulation System), wherein the medicine prototype support system does not reveal the identity of the confidential first main ingredient to the composition manufacturer system (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph).

Norris discloses information conversion means for selecting a second main ingredient having properties sufficiently similar (e.g., comparison 809) to the confidential main ingredient (see Figure 8 for "a flow diagram of a general process for a user to sort through a formulation database to select a set of matching formulations), but without using or revealing the first main ingredient (e.g., privately maintained formulation data) (see Page 11, Last Line of Second

Paragraph), but does not mention substitution. Iyer teaches to permit substitution thereof when making a prototype similar to a prototype using the first main ingredient (see Iyer: Page 6, Lines 2-3 and 18-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized substitution as taught by Iyer to the conversion of Norris because supply chain, enterprise and site planning applications and environments are widely used by manufacturing industries for providing product alternates to partners in a multi-enterprise collaboration (see Page 1: Lines 4-11).

As to independent claim 9, Norris discloses a medicine prototype support system for an ingredient manufacturer developing medical product (e.g., pharmaceutical) at a request of a product manufacturer (see Page 5, First Paragraph) comprising:

a database including first main ingredient information and second main ingredient information (e.g., direct fit) (see Page 5, Last two Paragraphs);

composition ingredient determination software that selects a composition ingredient based on the properties of the first and second main ingredients (see Page 8, Section 1. Formulation Know-How); and

a server for transmitting second main ingredient information and composition ingredient information to a composition manufacturer system (see Page 10, Last Paragraph), wherein the first main ingredient information is confidential information of the product manufacturer (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph), the second main ingredient information is non-confidential (e.g., granted access to

formulations the affiliates decide to make available to them) (see Page 5, Last Line of Second Paragraph), and the medicine prototype support system does not reveal the identity of the confidential first main ingredient to the composition manufacturer system (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph).

Norris discloses information conversion software that selects a second main ingredient having properties sufficiently similar (e.g., comparison 809) to the confidential main ingredient (see Figure 8 for "a flow diagram of a general process for a user to sort through a formulation database to select a set of matching formulations), but without using or revealing the first main ingredient (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph), but does not mention substitution. Iyer teaches to permit substitution thereof when making a prototype similar to a prototype using the first main ingredient (see Iyer: Page 6, Lines 2-3 and 18-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized substitution as taught by Iyer to the conversion of Norris because supply chain, enterprise and site planning applications and environments are widely used by manufacturing industries for providing product alternates to partners in a multi-enterprise collaboration (see Page 1: Lines 4-11).

As to independent claim 10, Norris discloses a method of requesting prototype manufacture from a composition manufacturer (see Page 5, First Paragraph) comprising the steps of:

receiving a request from a product manufacturer, the request including main ingredient information that is confidential (e.g., authorization; granted access) information of the product manufacturer (see Page 5, Last two Paragraphs);

storing (e.g., stored in the system database) the confidential first main ingredient information (see Page 5, Last two Paragraphs);

determining a composition ingredient based on the confidential main ingredient information and second main ingredient information (see Page 8, Section 1. Formulation Know-How);

transmitting a request for prototype manufacture to the composition manufacturer (e.g., customer for assembly) (see Page 13, Third Paragraph of Section 6. Formulation System), the request for prototype manufacture including the identities of the selected second main ingredient (e.g., formulation) and the selected composition ingredient (e.g., components) (see Page 13, Third Paragraph of Section 6. Formulation System); and

maintaining the confidentiality of the first main ingredient information by not transmitting it to the composition manufacturer (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph).

Norris discloses selecting a second main ingredient having properties sufficiently similar (e.g., comparison 809) to the confidential main ingredient (see Figure 8 for "a flow diagram of a general process for a user to sort through a formulation database to select a set of matching formulations), but without using

or revealing the first main ingredient (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph), but does not mention substitution. Iyer teaches to permit substitution thereof when making a prototype similar to a prototype using the first main ingredient (see Iyer: Page 6, Lines 2-3 and 18-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized substitution as taught by Iyer to the selecting of Norris because supply chain, enterprise and site planning applications and environments are widely used by manufacturing industries for providing product alternates to partners in a multi-enterprise collaboration (see Page 1: Lines 4-11).

As to dependent claim 11, Norris teaches the method of claim 10, further comprising transmitting a second request for prototype manufacture to a second composition manufacturer (see Page 7, First Paragraph of Detailed Description of the Invention).

As to dependent claim 12, Norris teaches the method of claim 10, wherein the confidential main ingredient information received from the product manufacturer (e.g., privately maintained formulation data) (see Page 11, Last Line of Second Paragraph) includes the identity of the main ingredient (e.g., formulations are developed by combining ingredients) (see Page 8, First Sentence of Section 1. Formulation Know-How).

Response to Arguments

9. Applicant's arguments filed November 19, 2007 are moot in light of new grounds of rejections necessitated by the amendment.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tejal J. Gami whose telephone number is (571) 270-1035. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TJG
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PRIMARY EXAMINER
12/9/2007